

REMARKS

Claims 1 and 4-21 are all the claims pending in the application. Claim 2 is cancelled, the recitation thereof having been incorporated into Claim 1. Claim 3 is cancelled, having been withdrawn from consideration as being directed to non-elected subject matter. Claims 1 and 4-21 have been amended to be commensurate in scope with the scope of Group IV, set forth in the election/restriction requirement. The claims have also been amended to correct improper multiple dependency and claims 1-9, 20 and 21, originally directed to a pharmaceutical composition for use in inhibiting human chymase, have been amended to recite a method of inhibiting human chymase activity. Accordingly, no question of new matter arises and entry of the amendments is requested, respectfully.

Requirement for New Title

The examiner required a new title.

The examiner's suggested title has been adopted.

Claim Objections

Claims 5-9 and 15-21 were objected to because they were in improper multiple dependent form.

The amended claims correct the improper multiple dependency.

Claim Rejections - 35 U.S.C. § 112

At page 5 of the office action, the examiner asserted that the preamble to claim 1 should recite a benzimidazole derivative, not an inhibitor against human chymase activity.

Claim 1 has been amended to recite a method. Accordingly, the rejection is moot.

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At page 6, first full paragraph, claim 10 was rejected as indefinite because it did not define all variables of the compound of formula (4).

Claim 4 has been amended to define said variables.

At page 6, second paragraph, claim 16 was objected to as lacking antecedent basis in claim 10, because claim 10 allegedly does not include the embodiment wherein J is a substituted phenyl.

The examiner appears to have misread claim 10, which states that "J" is a substituted naphthalene ring only when X_1 and X_2 are certain substituents.

This has been made clearer in amended claim 10.

Double Patenting

Claim 1, 2 and 4-21 were provisionally rejected under the judicially created doctrine of obviousness-type double patenting, as being unpatentable over claims 1, 2, 4-6, 8-11, 13 and 15 of copending application 09/743,483.

The examiner is respectfully requested to hold the rejection in abeyance until allowable subject matter is indicated in one of the two applications.

Claim Rejection - 35 U.S.C. § 102(a)

Claims 1, 2, 4-9 and 19-21 (now all method claims except for claim 19 which depends from non-rejected claim 10) were rejected under 35 U.S.C. § 102(a) as being anticipated by a) *Matsumoto et al.* (WO 2000/003997), b) Screening Collection (catalog published March 28, 2000), and c) Peakdale Fine Chemicals Product List (catalog published July 7, 2000).

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Claims 1, 4-9, 20 and 21 have been amended to recite a method of inhibiting human chymase activity.

Neither Screening Collection nor Peakdale Fine Chemicals Product List teaches or discloses that the compounds have human chymase inhibiting activity. Therefore, the references cannot anticipate the rejected claims.

Furthermore, sworn translations of both of the documents from which applicants claim priority are submitted herewith. Since each of the references was published after the priority date of both priority documents, any subject matter of each of the references relied upon by the examiner is antedated to the extent the subject matter is disclosed in the priority documents. Accordingly, the examiner is respectfully requested to reconsider the restriction in view of the foreign translations of the priority documents.

The rejection of claim 19 is believed to have been a mistake, since claim 19 depends from non-rejected claim 10.

Claim Rejection - 35 U.S.C. § 102(b)

Claims 1, 2, 4-9 and 19-21 were rejected under 35 U.S.C. § 102(b) as being anticipated by a) *Yoshida et al.* (JP 03-014566 or CA 115:71600, 1991), b) *Nicolai et al.* (Journal of Medicinal Chemistry, 1993, c) *Bru-Magniez et al.* (U.S. Pat. 5,021,443), d) *Bru-Magniez et al.* (U.S. Pat. 5,124,336), and e) *Bru-Magniez et al.* (U.S. Pat. 5,128,359).

Claims 1, 4-9, 20 and 21 have been amended to recite a method of inhibiting human chymase activity. None of the cited references teaches or suggests that the compounds have

human chymase inhibiting activity. Therefore, these references cannot anticipate the rejected claims.

The rejection of claim 19 is believed to have been a mistake, since claim 19 depends from non-rejected claim 10.

Claim Rejection - 35 U.S.C. § 103

Claims 1, 2 and 4-21 were rejected under 35 U.S.C. § 103(a) as being unpatentable over *Bru-Magniez et al.* (U.S. Pat. 5,021,443), *Bru-Magniez et al.* (U.S. Pat. 5,124,336), *Bru-Magniez et al.* (U.S. Pat. 5,128,359), and *Matsumoto et al.* (WO 2000/003997) each taken alone or in combination.

The examiner asserted that various compounds disclosed in each of these references are structurally similar to the presently claimed compounds, and, therefore, one of ordinary skill in the art reading any of these references would readily make the necessary substitutions and/or modifications to the compounds of the cited references in order to obtain the presently claimed compounds.

As to the method claims, all of the cited references, other than *Matsumoto et al.*, are silent concerning human chymase inhibitory activity. As to *Matsumoto et al.*, applicants note that although the cited compound No. 444 falls within the scope of the disclosure in applicants' priority document JP 2000-01406 ($X^1=X^2=Me$, A=benzene ring, E=naphthyl, B=S, $R^1=R^2=H$, $n=0$, $D=COOR^8$, $R^8=H$), the closest compound is compound 129.

The examiner is requested to reconsider the rejection of the method claims over *Matsumoto et al.* in view of the submission of the sworn translations of applicants' priority documents.

As to the compound claims, applicants note the following:

a) *Matsumoto et al.*

The examiner is respectfully requested to reconsider the rejection in view of the above comment and the disclosure of the sworn translations of the priority documents.

b) *Bru-Magniez et al.*

Applicants note that the compounds of Example 63 of the '443 patent, Example 59 of the '336 patent and Example 64 of the '359 patent are excluded from claim 10 because of the proviso. Applicants further advise that *Bru-Magniez* also provides several examples having a naphthalene ring at the J position of the present invention, since X₃ and X₄ of formula (I) can also form a naphthalene ring together with the adjacent phenyl ring. See Example 84 of the '433 patent and Example 147 of the '336 patent. However, these examples are also excluded by the proviso in claim 10, because these naphthalene rings are not substituted, while the present invention requires substituents on the naphthalene ring.

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the examiner feels may be best resolved through a personal or telephone interview, the examiner is kindly requested to contact the undersigned at the telephone number listed below.

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Respectfully submitted,



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CUSTOMER NUMBER

Date: September 30, 2003